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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,079	01/14/2004	Michael Ian Birrell	797.005	5345

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BOYLE FREDRICKSON S.C.
840 North Plankinton Avenue
MILWAUKEE, WI 53203

EXAMINER

EDWARDS, NEWTON O

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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05/06/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/757,079

Applicant(s)

BIRRELL, MICHAEL IAN

Examiner

N Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) 12-14, 17, 19 and 20 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11, 15, 16, 18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

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Applicant argues the restriction after it was made FINAL saying that 1) a valid restriction must prove a burden as stated in MPEP 803.

For the record, an undue burden on the Examiner was shown in the restriction dated 3/20/07 by the divergent subject matter and different classification. At applicant's request of the Pre-Appeal Brief Review decision dated 3/8/07, it was determined that prosecution would be reopened, thus a restriction was issued (the first time this Primary Examiner viewed the case). Thus the issue is moot.

Applicant urges that 2) **it is not any given applicant's responsibility to educate those without ordinary skill in the art and/or use a claimed invention.**

Interesting.

Applicant urges that somewhere in his spec it states 3) "...multilayer product may be... Pressing or vacuum consolidating...shaped mold".

Assuming you are talking about page 5 lines 1-5 of your spec, first of all, you are no longer claiming a multilayered product. Nowhere in your pending claims is a multilayered product claimed. You are claiming **NEW** Matter a single consolidated product and consolidation to form generally a whole (found in claims 1 and 15). The **New** Matter was added to claims 1 in an amendment dated 4/3/06 and claim 15 in an amendment dated 5/21/06. Applicant has changed his invention again.

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Applicant urges that 4) again, the **Examiner makes statement that is on its face-not true**, that Applicant failure to disclose a consolidation temperature and pressure yields 112 rejections, see original claim 13.

Let's be clear, you have failed to show that this Primary Examiner has made any untrue statement at all. Original claim 13 is not claimed, *agruendo* it was claimed, it added no life of your spec. Original claim 13 mention the words under pressure but fail to tell a pressure or mention a single consolidation product is formed (or a consolidation to form generally a whole). Original claim 13 mention the word glass transition temperature for making a multilayer product, which is not claimed. See the response to argument 3 for a response.

Applicant urges that 5) **even one absent ordinary skill in the art would appreciate the plain meaning of there terms consolidated to form generally a whole and isotropic.**

Interesting.

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Applicant argues that 6) he already explained in a previous paper filed dated 2/2/07 that consolidated is joined together into one whole. Isotropic is something that exhibits properties with the same values when measured along axes in all directions.

What are you talking about ? The paper dated 2/2/07 is your request to a Pre-appeal Brief request for another examiner. This 112 rejection was given 9/12/07 longer after, your request. You have not stated where in your spec you are getting your well timed and creative definitions.

Applicant urges that 7) regarding the ODP rejection, see MPEP822.01 , the examiner should withdrawn the rejection and permit the application to issue as a patent. Wishful thinking and the rejection is maintained.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification as filed is objected to for failing to provide support for the invention as is now claimed.

The specification as filed fails to provide support for 1) Claim 1, line 6 "to form a single consolidated product" and 2) Claim 15, line 9 "are consolidated to forma generally a whole".

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Claims 1-11, 15, 16, and 18 are rejected under 35 USC 112, first paragraph, for the reasons given in the objection above.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification as filed 1) fails to provide an adequate written description of the invention and 2) failing to provide an enabling disclosure.

The specification as filed 1) fails to provide any written description for Claim 1 line 6 "to form a single consolidated product", 2) fails to provide any written description for claim 15, line 9 "a painted multilayer product .. are consolidated to form generally a whole", 3) what temperature and pressure are used to make a single consolidated product (or consolidated to form generally a whole) of claim 1 and claim 15, 4) What defines or constitute the phrase consolidated to form generally a whole, 5) How to make the single consolidated product (or consolidated to form generally a whole) of claims 1 and 15, 6) what is the final structure of a mold having a desired shape of claim 18, 7) what defines or constitute multiple cover layers to be different so as to be considered isotropic in claim 18? what makes them different and who considered them (subjective) isotropic, The specification also fails to provide any guide or direction of how to make a single consolidated product (or consolidated to form generally a whole) of claims 1 and 15 and what temperature and pressures are used to form the single consolidated product. The specification has no working examples of how a single consolidated

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product (or consolidated to form a generally a whole) of claims 1 and 15. The specification at page 2, lines 16-17 and page 5, lines 1-6 fails to disclose the final product structure.

Claims 1-11, 15, 16, and 18 are rejected under 35 USC 112, first paragraph, for the reasons given in the objection above.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of copending Application No. 11/572,297. Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant filed genus and species claims in 11/572,297 and 10/757079. Thus obviousness-type double patenting is met since the genus claims include the species claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 2-11, 15 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-11, and 18 are indefinite and vague since the claims fail to further limit the single consolidated product (final product) of claims 1 and 15. The substrate and the cover layer (intermediate products) are no longer present when the final product (single consolidated Product) is formed.

Claim 15, line 9 "consolidated to from generally a whole" is vague and indefinite as to the meaning of the phrase.

Claim 18, line 3 "different so as to be considered isotropic" is indefinite and vague as to how the cover layers are different and "so as to be considered isotropic" is indefinite since this is a subjective limitation which can change from person to person.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-11 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Huang (US 6,699,427).

For the record, the invention defined by a product by process claim is a Product and NOT a process. Also, the invention defined by an intermediate final Product claim is a Final product. Thus the Final product formed from claims 1-11 is a single consolidated product having the density of less than 1.2 g/cm cubed.

Hanug teaches a Carbon composite (single consolidated product) made from multiple layer which heated and press in a mold and having a density of 0.6 to 1.3 g/cm cubed. See col.1 lines 45-56 , for example.

No Claims are allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number 571-272-1521.

/N Edwards/
Primary Examiner
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